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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,401	07/01/2003	Manabu Sato	239707US0	9350
22850	7590	11/29/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			FERNANDEZ, SUSAN EMILY	
			ART UNIT	PAPER NUMBER
			1651	
DATE MAILED: 11/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/609,401

Applicant(s)

SATO ET AL.

Examiner

Susan E. Fernandez

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1,3-5 and 7.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

### **ATTACHMENT TO ADVISORY ACTION**

The response filed November 9, 2005, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

The 11-9-05 amendment raises new issues of search and consideration since the claims previously did not require storing the immobilized enzyme after dehydrating as recited in new claim 8, and was not considered previously. However, it does not appear that Shimizu et al. (EP 1,008,647) fails to overcome the recitation "a composition consisting essentially of at least one of" in claim 3, since the preamble of claim 3 does not exclude an esterification reaction.

Finally, the new language in the proposed amendment requires consultation of the specification to confirm support for the new language. Therefore, denial of entry of the proposed amendment is proper at this after-final stage of prosecution.

All of applicant's argument has been fully considered but is not persuasive of error. It is respectfully pointed out that Shimizu et al. does disclose or suggest a separate dehydration step in the preparation process since, as discussed in the previous office action, '647 teaches a preferable embodiment wherein "the immobilized enzyme after immobilized by adsorption is deprived (or removed) of water sufficiently by a physical method and then brought into contact with the substrate to effect the esterification reaction" (paragraph [0037]), and in Comparative Example 1 (paragraph [0047]), the water content of the immobilized enzyme is lowered under reduced pressure. The applicant also argues that the reference does not consider the physical removal of water described in paragraph [0037] a drying step. However, it is respectfully noted

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that the comparison of paragraph [0034] and [0037] used in order to come to this assertion is improper, since they are used to described separate inventions (see paragraphs [0032] and [0035]).

Additionally, Shimizu et al. indeed discloses the dehydration of an immobilized enzyme **after** the immobilized enzyme is brought into contact with fat/oil. Specifically, see page 5, lines 3-7 (paragraph [0038]) of '647 and the last paragraph of page 4 of the previous office action. Nevertheless, Comparative Example 1 anticipates claim 3 since claim 3 **comprises** of the claim-recited steps, thus the dehydration step may occur before step ii). Furthermore, the recitation "without directly drying" in claim 3 only speaks to the step of contacting the immobilized enzyme with the composition, rather than what occurs prior to the moment of contact.

Since Shimizu et al. ('647) anticipates claims 3, 4, and 7, the rejections of claims 1, 3-5, and 7 under 35 U.S.C. 103(a) over '647 in view of '575 and Ruthven are proper. Arguments with respect the Sato declaration have been considered but are not persuasive of error. As indicated in the previous office action, the declaration only speaks to the case where 400% by weight of oil based on the weight of carrier is used, rather than all other amounts of oil that are rendered obvious by the references. Therefore, the declaration does not eliminate all possibilities that the invention rendered obvious by '647 would not have resulted in the recited moisture content.

No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan E. Fernandez whose telephone number is (571) 272-3444. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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